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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/770,396

02/04/2004

Byoung-Yue Kim

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EXAMINER

KAU, STEVEN Y

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/770,396	Applicant(s) KIM, BYOUNG-YUE	
	Examiner STEVEN KAU	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 5/27/2008, and has been entered and made of record. Currently, claims 1-14 are pending.

Response to Remark/Arguments

2. Applicant's arguments, section "Rejection Under 35 U.S.C. § 112", page 5, with respect to 7-12 have been fully considered and are persuasive. The rejection of claims 7-12 under 35 U.S.C. § 112 Second Paragraph has been withdrawn.

Regarding applicant's arguments, section "Rejection under 35 U.S.C. §102"

Applicant's arguments, "**However, while Mochizuki does discuss receiving a network address and receiving a port number of a printer, Mochizuki does not discuss or suggest receiving identification numbers of each of the printers, such as the port numbers, and then receiving a network address of selected printer corresponding to a predetermined identification number from among the received identification numbers. In Mochizuki, the identification numbers, i.e., the port numbers, and the printer ID address are both sent at the same time and in the same printer response packet to the host 10. However, in Mochizuki, the port numbers of the printers connected to the network are not first received by the host 10 and then the network address of a selected printer corresponding to a predetermined identification number from among the received identification numbers is received by the host 10. The printer ID address and the port numbers are sent at the same time. Therefore, Mochizuki does not suggest receiving a network address of a selected printer corresponding to a predetermined port number from among the already-received port numbers**", section II, pages 5-6.

In re, the examiner respectfully disagrees. As applicant admitted that “Mochizuki discusses a host 10 that includes a printer retrieval unit 48 sending a broadcast printer retrieval packet to retrieve a printer from a network. The printer retrieval packet includes information required for the execution of communication between the printer and the host, such as the host IP address and port number. When the packet is received at a printer, the printer sends a response packet to the host, the response packet including information required for communication between the host 10 and the printer, such as the printer IP address and the port number”, (emphasis added by the examiner), Section II, page 5. One skilled in ordinary art knows that communication between a host (or a computer) and a networked printer must be with a network protocol and packets. Mochizuki discloses a process of requesting and receiving identification number of printers. For instance, host 10 sends out a printer retrieval packet with a specific port number XXXX (predetermined port number) and the printer verifies the port number XXXX and sends response packet back to the host with an identifier indicative of response information (col 6, lines 16-50); then the host issues a print request packet including IP address and port number (col 7, lines 1-14); in response to the host print request, the printer sends a response packet to host including IP address, port number and printer ID such as the printer name (col 7, lines 33-55). Thus, the arguments **“Mochizuki does not discuss or suggest receiving identification numbers of each of the printers, such as the port numbers, and then receiving a network address of selected printer corresponding to a predetermined identification number from among the received identification numbers”** and **“Therefore, Mochizuki does not suggest receiving a network address of a selected printer corresponding to a predetermined port number from among the already-received port numbers”** are not persuasive.

Applicant further argues that “As discussed above, Mochizuki discusses requesting the printers to transmit identification numbers and receiving the identification numbers. However, Mochizuki does not discuss or suggest generating an address request signal requesting a network address of a specific printer among the printers in response to a print request. Mochizuki discusses requesting printer ID addresses from a number of printers, but Mochizuki does not discuss or suggest generating an address request signal requesting a network address of a specific printer among the printers connected to the network that have sent the identification numbers”, Section II, page 7.

In re, the examiner respectfully disagrees. As discussed above, Host 10 specifies a port number XXXX in the printer retrieval packet (col 6, lines 16-40) and the printer verifies the packet addressed to the port number XXXX; then sends response packet back to host; the host sends out a print request packet including IP address and port number and printer in reply sends a response packet back to the host, again, including IP address, port number and printer ID information (col 7, lines 1-55). If the host does not generate an IP address request signal requesting a network address (or IP address), how can a print request pack include IP address and port number in communicating with the networked printer? Thus, the argument "As discussed above, Mochizuki discusses requesting the printers to transmit identification numbers and receiving the identification numbers. However, Mochizuki does not discuss or suggest generating an address request signal requesting a network address of a specific printer among the printers in response to a print request. Mochizuki discusses requesting printer ID addresses from a number of printers, but Mochizuki does not discuss or suggest generating an address request signal requesting a network address of a specific printer among the printers connected to the network that have sent the identification numbers” is not persuasive either.

Regarding applicant’s arguments, section “Rejection under 35 U.S.C. §103”

Applicant argues that “As discussed above, Mochizuki does not discuss or suggest all the features of independent claims 1 and 7. Motoyama fails to make up for the deficiencies in Mochizuki. Therefore, claim 1 and 7 patentably distinguish over the references relied upon. Claims 6 and 12 depend directly from independent claims 1 and 7 and include all the features of their respective independent claims, plus additional features. Therefore, claims 6 and 12 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of the §103(a) rejection is respectfully requested”, section III, page 7-8.

In re, the examiner disagrees with the statement. As discussed above, Mochizuki's disclosure reads all claim limitations and therefore, the rejection ground is valid and still stands.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 7-11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Mochizuki (US 7,113,298).

Regarding claim 7.

Mochizuki discloses an apparatus (**Host 10 and the networked printer in Fig. 1**) for printing data using an identification number of a printer (e.g. **Printer ID, col 7, lines 40-42**) to

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perform a printing process through a network in which a plurality of printers are respectively connected to a plurality of computers (**Fig. 1**), comprising: a port setting portion (**e.g. printer retrieval unit 48 of Fig. 7**) which requests the printers to transmit identification numbers in response to a printer port set request (**Fig. 9 teaches printer retrieval with an identifier indicative of a request for printer by Host 10, col 6, lines 7-57**) and which stores the received identification numbers (**e.g. retrieved printer information, including printer identifier and IP address is stored as part of Driver 25 of Fig. 7, and therefore, this information can be displayed as a GUI posting to the operator, col 7, lines 40-55**); an identification number transmitting portion (**printer retrieval responding unit 56 of Fig. 8**) which transmits the requested identification numbers (**e.g. IP address and port number, col 8, line 53 through col 9, line 8**); a request signal generating portion (**Printer retrieval packet of Fig. 9 & print request packet of Fig. 11**) which generates an address request signal requesting a network address (**printer IP address**) of a specific printer among the printers having sent the identification numbers in response to a print request (**col 6, lines 10-57 & col 7, lines 5-32**) and which outputs the generated address request signal (**Figs. 7 and 8, col 6, lines 7-57**); an address transmitting portion (**response packet from printer of Fig. 10**) which transmits the network address in response to the address request signal (**col 6, lines 38-57**); an address receiving portion (**Printer Retrieval Unit 48 of Fig. 7 & Step 9 of Fig. 13, col 7, line 56 through col 8, line 8**) which receives the transmitted network address (**col 6, lines 48-64**); a data transmitting portion (**Application 16 & port 30 of Fig. 7**) which transmits print data to the specific printer (**Figs. 14a-b, & Figs 15a-b, col 10, line 51 through col 11, line 6**); and a print portion which prints the transmitted print data (**"host posts the print data transfer unit 52 to start the**

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printing processing in step S18”, col 10, lines 51-67, one of skilled in the art understands that printer prints out the transmitted print data and col 14, lines 34-52).

Regarding claim 1.

Claim 1 recites identical features as claim 7, except claim 1 is a method claim. Thus, arguments similar to that presented above for claim 7 are also equally applicable to claim 1.

Regarding claim 13.

Claim 13 recites identical features as claim 7, except claim 13 is a method claim. Thus, arguments similar to that presented above for claim 7 are also equally applicable to claim 13.

Regarding claim 8.

Mochizuki discloses wherein the address request signal includes an identification number corresponding to the specific printer (**e.g. a printer IP address and port number, col 6, lines 50-53).**

Regarding claim 9.

Mochizuki discloses an identification number checking portion (**response packet from printer of Fig. 10**) checking (judging) whether an identification number of a printer having the address transmitting portion and the predetermined identification number are the same, in response to the address request signal having the predetermined identification number, and outputting (unicast) the result of check as a check signal (**Fig. 13, col 7, line 56 through col 8, line 27**); and a transmission portion transmitting (unicast) the network address (IP address) of the predetermined printer having the same identification number in response to the check signal (**Fig. 13, col 7, line 56 through col 8, line 27, and Figs 15a-b, col 8, line 53 through col 9, line 8**).

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Regarding claim 10.

Mochizuki discloses wherein the network address is one of an Internet protocol (IP) address, an Internet packet exchange (IPX) address, and a media access control (MAC) address **(col 6, lines 50-57)**.

Regarding claim 11.

Mochizuki discloses the identification numbers are printer port registration information **(col 6, lines 50-57)**.

Regarding claim 2.

Claim 2 recites identical features as claim 9, except claim 2 is a method claim. Thus, arguments similar to that presented above for claim 9 are also equally applicable to claim 2.

Regarding claim 3.

Claim 3 recites identical features as claim 10, except claim 3 is a method claim. Thus, arguments similar to that presented above for claim 10 are also equally applicable to claim 3.

Regarding claim 4.

Claim 4 recites identical features as claim 8, except claim 4 is a method claim. Thus, arguments similar to that presented above for claim 8 are also equally applicable to claim 4.

Regarding claim 5.

Claim 5 recites identical features as claim 11, except claim 5 is a method claim. Thus, arguments similar to that presented above for claim 11 are also equally applicable to claim 5.

Regarding claim 14.

Claim 14 recites identical features as claim 8, except claim 14 is a method claim. Thus, arguments similar to that presented above for claim 8 are also equally applicable to claim 14.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochizuki (US 7,113,298) as applied to claims 1 and 7 above, and in view of Motoyama et al (Motoyama) (US 6,839,717).

Regarding claim 12.

Mochizuki teaches using print's name as printer identifier in network printing (**col 7, lines 45-50**).

Mochizuki differs from claim 12, in that he does not expressly teach wherein the identification numbers are printer serial numbers.

Motoyama teaches wherein the identification numbers are printer serial numbers (**col 32, lines 7-34**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Mochizuki to include wherein the identification numbers are printer serial numbers, but Mochizuki teaches using print's name as printer identifier in network printing taught by Motoyama to a flexible, quick and easy way to determine or identify a device for communication (**col 4, lines 10-52**).

Regarding claim 6.

Claim 6 recites identical features as claim 12, except claim 6 is a method claim. Thus, arguments similar to that presented above for claim 12 are also equally applicable to claim 6.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kau whose telephone number is 571-270-1120 and fax number is 571-270-2120. The examiner can normally be reached on Monday to Friday, from 8:30 am -5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Steven Kau/
Examiner, Art Unit 2625
8/18/2008

/King Y. Poon/
Supervisory Patent Examiner, Art Unit
2625